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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/787,142

02/27/2004

Bruce Elliot Kramer

SOAP1

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BRUCE ELLIOT KRAMER
9112 CHERBOURG DR.
POTOMAC, MD 20854

EXAMINER

OGDEN JR, NECHOLUS

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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01/27/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/787,142	Applicant(s) KRAMER ET AL.	
	Examiner Necholus Ogden, Jr.	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24, 26 and 30-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24, 26, 30-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

Claims 24, 26, 30-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sonnenberg et al (6,673,756).

Sonnenberg et al disclose a multiphase soap comprising two or more phases wherein each phase may be opaque and/or comprise different color(s) or dye(s) (col. 21, lines 60-64; col. 26, lines 30-35 and claims 1-5). Sonnenberg et al further teach that said multiphase soap bar comprises an antibacterial components (col. 15, lines 14-42) and further teach that said bar comprises an object for advertising purposes such as a toy of gold or similar materials (col. 21, lines 50-col. 22, line 16).

Sonnenberg et al do not teach with sufficient specificity to anticipate the claims comprising each of the colors in specific layers.

It would have been obvious to one of ordinary skill in the art to disperse the various colors in a specific layers as claimed because Sonnenberg et al teach a multiphase soap bar having two or more phases in different colors (col. 26, lines 30-35). Moreover, one of ordinary skill would have been motivated to comprise a soap bar with a variety of colors for aesthetic reasons or for advertisement considerations. Accordingly, one of ordinary skill in the art would construe specific colors or layers as matters relating to ornamentation or aesthetic design changes which have no mechanical function and therefore cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

Response to Arguments

1. Applicant's arguments filed 11-05-2009 have been fully considered but they are not persuasive.
2. Applicant argues that In particular, claim 24 now recites that (1) the outside layer of the present invention surrounds the at least one inside layer, (2) the layers are opaque, and (3) the outside layer disappears due to the washing or bathing, thereby changing the color of the cleansing bar.

First, the examiner contends that applicant's claims do not state that the inside layer is not visible, but that the outside layer is a different color than at least one inside layer (see claim 24). Therefore, the argument with respect to visibility is not well founded since one inside layer can be different but other inside layers may be the same as the outside layer. Moreover, applicant does not have support for his assertion of the visibility of the inside layer in his specification. Secondly, as for the particular arrangement of colors and layers recited in the applicant's claims, the numerous arrangements disclosed in Sonnenberg's figures indicate that selection of layer arrangements and colors including those recited in the applicant's claims would have required no more than ordinary creativity by one of ordinary skill in the art to provide a functional cleansing bar having the desired appearance. See *KSR Int 7. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (In making an obviousness determination one "can take account of the inferences and creative steps that a person of ordinary skill in the art would employ"). Moreover, Sonnenberg teaches that layers are opaque (col. 26, lines 31-33). Due to washing or bathing, the layers in each of those

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bars would disappear (first outer and then inner) and the appearance of the multicolored cleansing bar would change as the colors get mixed together and the layers disappear.

Applicant argues that the soap bars of Sonnenberg et al do not motivate a child to wash and improve their hygiene by providing a bar with rainbow colors and a prize identifier such as a pot of gold as recited in claim 58.

The examiner contends and respectfully disagrees because the prior art of record, Sonnenberg et al teach bars with a variety of colors and layers and one skilled in the art would have been motivated to assemble the layers and colors as claimed for aesthetic or commercial purposes, absent a showing to the contrary. With respect to motivating a child to wash, the examiner contends that this would be an inherent property of the soap bars because as Sonnenberg et al teach layered soap bars with a plurality of colors in a variety of arrangements and formulated with surfactants, one skilled in the art would expect said soap bars to used for the inherent purpose of motivating any human, and including a child, to wash or bathe with said bar. With respect to improving a child's hygiene, the examiner contends that the soap bars have cleansing phases, which would clean and improve the hygiene of a child if used as a cleansing personal soap bar as suggested by Sonnenberg et al. With respect to the prize identifier or pot of gold, Sonnenberg et al teach that said bar comprises an object for advertising purposes such as a toy of gold or similar materials (col. 21, lines 50-col. 22, and line 16). Accordingly, the courts held that reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the

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combination to achieve the same advantage or result discovered by applicant. In re Linter, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972) (In re Dillon, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991)) "it is not necessary in order to establish a prima facie case of obviousness . . . that there be a suggestion or expectation from the prior art that the claimed [invention] will have the same or a similar utility as one newly discovered by applicant," and concluded that here a prima facie case was established because "[t]he art provided the motivation to make the claimed compositions in the expectation that they would have similar properties."

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Necholas Ogden, Jr. whose telephone number is 571-272-1322. The examiner can normally be reached on M-Thu.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Necholus Ogden, Jr./
Primary Examiner
Art Unit 1796

no